

REMARKS

Summary of Office Action

Claims 1-46 and 75-117 are pending in this application.

The Examiner rejected claims 1, 2, 6, 24, 25, 29, and 75 under 35 U.S.C. § 102 as being anticipated by Hendricks et al. U.S. Patent No. 5,34,853 (hereinafter "Hendricks").

Claims 1-5, 12-15, 18, 20-28, 35-38, 41, 43-46, 75-77, 85, 86, 89, 91-99, 106-109, 112, and 114-117 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr et al. U.S. Patent 6,209,129 (hereinafter "Carr") in view of Klosterman et al. U.S. Patent 5,940,073 (hereinafter "Klosterman").

Claims 6-8, 10, 29-31, 33, 78-80, 82, 100-102, and 104 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Berezowski et al. U.S. Patent 6,075,551 (hereinafter "Berezowski").

Claims 9, 11, 32, 34, 81, 83, 103, and 105 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Chen et al. U.S. Patent 5,917,830 (hereinafter "Chen").

Claims 19, 42, 90, and 113 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view

of Klosterman, and further in view of Klosterman et al. U.S. Patent 6,078,348 (hereinafter "the '348 patent").

Claims 16, 39, 87, and 110 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Kikinis U.S. Patent 5,929,849 (hereinafter "Kikinis").

Claims 17, 40, 88, and 111 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Kikinis and Berezowski et al. U.S. 6,064,376 (hereinafter "the '376 patent").

Applicants' Reply to the
Rejection under 35 U.S.C. § 102(e)

Claims 1, 2, 6, 24, 25, 29, and 75 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hendricks. Applicants respectfully traverse this rejection.

Applicants' invention, as defined by independent claims 1, 24, 75, and 95, relates to systems, a method, and a machine readable medium for distributing local advertisements specific to a particular geographic region to user television equipment. The interactive television program guide displays the local advertisements and provides a user with an opportunity to select the local advertisements (e.g., in order to obtain additional information about an advertised product or service or to order an advertised product or service).

Hendricks refers to a television program delivery system in which a menu interface is provided to enable users to access television programming.

In asserting that Hendricks shows all the features of applicants' claimed invention, the Examiner refers to Hendricks' description of a packaged signal that has instructions for enabling a local cable or television company to fill available programming time with local programming and local advertising (Office Action, page 5). The Examiner is relying on this disclosure of Hendricks to show local advertisements are displayed by the program delivery system. This local programming and local advertising is content that is broadcast like any other type of television programming. It is not content that is being displayed in an interactive television program guide (e.g., in distinct advertisement regions). For example, if a user is viewing a nationally televised program (e.g., a syndicated sitcom), an advertisement sponsored by the user's local hardware store may be broadcast during a commercial break. Therefore, the local programming and local advertising that are inserted into the packaged signal are not local advertisements that are being distributed to user equipment for display in an interactive television program guide, as defined in applicants' claims 1, 24, and 75.

The Examiner further points to Hendricks' description of menus that are generated and displayed to

assist the user in selecting programming (Office Action, page 5). The Examiner is relying on this disclosure of Hendricks to show that users can select local advertisements. Accessing a program through a menu, even if the menu is displaying advertisements, has nothing to do with allowing the user to select an advertisement in the context of applicants' invention. In fact, although these menus may provide advertising or promotional information, nothing in Hendricks shows or suggests that this advertising and promotional information is selectable. The advertising and promotional displays in Hendricks are passive. There is no interactivity involved with these displays. Therefore, even assuming that the advertisements being displayed in these menus are local advertisements, Hendricks does not show or suggest that these alleged local advertisements are selectable, as defined by applicants' claims 1, 24, and 75.

The Examiner further refers to Hendricks' description of subscriber region designation 926, which indicates the geographic region of the user's set-top terminal (Office Action, page 5). The Examiner relies on this disclosure of Hendricks to show that the local advertisements are specific to a particular geographic region. The subscriber region designation is used when user set-top terminals are being polled for information such as user activity data (see generally, Hendricks, column 17, lines 24-62). This subscriber region designation is

inclusive only to polling functionality. It is not used for distributing advertisements that are specific to a particular geographic location, nor is it suggested that it can be used for such purposes. Therefore, Hendricks fails to show distributing local advertisements to user television equipment in specific geographic locations for display in an interactive television program guide.

Accordingly, for at least the reasons that the local programming and local advertising being inserted into a packaged signal of Hendricks is not local advertising that is displayed with the interactive television program guide, that the advertising and promotional information of Hendricks is not selectable, and that the subscriber region designation of Hendricks is not used to distribute local advertisements to specific geographic regions, the rejection of claims 1, 2, 6, 24, 25, 29, and 75 should be withdrawn.

Applicants' Reply to the
Rejection under 35 U.S.C. § 103(a)

Claims 1-5, 12-15, 18, 20-28, 35-38, 41, 43-46, 75-77, 85, 86, 89, 91-99, 106-109, 112, and 114-117 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman. Applicants respectfully traverse this rejection.

Carr "relates to passive television program guides, and more particularly, to techniques for providing local information with such passive television program

guides" (column 1, lines 7-11). As defined in Carr, "a passive program guide system . . . provides users with program guide information, promotional information, and regional advertising without requiring that the user have any special television equipment other than a standard television" (column 2, lines 39-43). That is, passive program guides provide information to the user without enabling a user to access any interactive features.

Klosterman refers to an interactive program schedule guide.

The Examiner acknowledges the novelty of applicants' invention over Carr, but contends that it would be obvious to modify Carr to incorporate an interactive television program guide as taught by Klosterman in order to give the user an opportunity to activate an icon, click on a region, or select a menu item to view additional information about the product or services advertised.

Applicants respectfully submit that the Examiner has failed to point out the requisite motivation necessary to present a rejection of claims under 35 U.S.C. § 103(a). The Examiner contends that

it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Carr to incorporate an interactive television program guide as taught by Klosterman in order to allow the user to interact with the user interface for additional information, and thereby give the user [convenient access] to [obtaining] additional information of the advertisement being displayed on the screen

(Office Action, page 4, lines 1-6). However, applicants respectfully submit that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" (MPEP § 2143.01).

Applicants respectfully submit that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Carr or Klosterman that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Instead of providing an objective teaching of a motivation to combine Carr and Klosterman, the Examiner merely concludes that it would have been obvious to combine

Carr and Klosterman for providing the user with convenience if the user wants to find out additional information of the advertisement being displayed on the screen (Office Action, page 4, lines 4-6). None of these reasons point to any objective teaching that would lead one of ordinary skill in the art to combine the references to obtain applicants' invention, especially in light of the fact that Carr teaches a passive television program guide.

Applicants concede that motivation need not be a direct statement in one reference pointing to the other. However, for motivation to exist, there either has to be something in one reference or something well known in the art that causes the reader to look to another reference. Because Carr is directed to a passive television program guide that displays information, there is no motivation to look to Klosterman to inject interactive functionality into the passive program guide of Carr. Furthermore, Carr specifically states that passive television program guides are not capable of providing the user with any interactive features (Carr, column 1, lines 23-25). Thus, Carr lacks any motivation that would cause one skilled in the art to be modified to include any interactive functionality, such as that disclosed by Klosterman.

The Examiner refers to the notoriety of interactive television programming art as an implication of an existence of a motivation. Simply stating that something

is well known is not, in and of itself, motivation. This would mean that if anything is known, there is an automatic motivation to combine that which is known with anything however remotely related. Here, the Examiner contends that interactive television program guides are well known, and as such, it would have been obvious to combine their interactivity in what was explicitly intended only to be a passive electronic program guide, which purposely lacks interactive functionality. Applicants submit that such a basis for motivation is improper.

Applicants respectfully submit that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicants' novel approach of displaying local advertisements in an interactive television program guide and allowing the user to select the local advertisements in mind, particular features of the prior art were identified for use in rejecting applicants' invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine at 1600 ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicants' own invention as a bridge between Carr and Klosterman. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the

very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak at 1617-1618. For this reason alone, the rejection of claims 1-5, 12-15, 18, 20-28, 35-38, 41, 43-46, 75-77, 85, 86, 89, 91-99, 106-109, 112, and 114-117 must be withdrawn. Gambro Lundia AB v. Baxter Healthcare Corp., 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Because the Examiner failed to point to a suggestion or motivation for modifying Carr with the teachings of Klosterman, applicants respectfully submit that the Examiner has failed to make a *prima facie* case of obviousness (MPEP § 2142).

Not only is there no motivation or suggestion to combine Carr with Klosterman, the references actually teach away from being combined. Carr specifically states: "[p]assive television program guides are not capable of providing the user with any interactive features" (column 1, lines 23-25). In addition, Carr does not require that the user have any special equipment, such as a set-top box, to benefit from a passive television program guide system (column 2, lines 39-45). If interactive functionality is desired, addition equipment, such as a set-top box, is needed.

Accordingly, for at least the reasons that there is no motivation nor suggestion to combine Carr and

Klosterman, that impermissible hindsight was used to combine the references, and that the references teach away from each other, claims 1, 24, 75, and 95 are allowable. Dependent claims 2-5, 12-15, 18, 20-23, 25-28, 35-38, 41, 43-46, 76, 77, 85, 86, 89, 91-94, 96-99, 106-109, 112, and 114-117 are also allowable because they depend from independent claims 1, 24, 75, and 95.

For at least the above reasons, applicants respectfully request that the rejections of claims 1-5, 12-15, 18, 20-28, 35-38, 41, 43-46, 75-77, 85, 86, 89, 91-99, 106-109, 112, and 114-117 under 35 U.S.C. § 103(a) be withdrawn.

Applicants' Reply to the Remaining Rejections under 35 U.S.C. § 103(a)

Claims 6-8, 10, 29-31, 33, 78-80, 82, 100-102, and 104 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Berezowski.

Claims 9, 11, 32, 34, 81, 83, 103, and 105 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Chen.

Claims 19, 42, 90, and 113 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of the '348 patent.

Claims 16, 39, 87, and 110 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Kikinis.

Claims 17, 40, 88, and 111 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Kikinis and the '376 patent.

Because applicants have demonstrated in the foregoing that claims 1, 24, 75, and 95 are allowable, dependent claims 6-11, 16, 17, 19, 29-34, 39, 40, 42, 78-83, 87, 88, 90, 100-105, 110, 111, and 113 are also allowable.

Conclusion

The foregoing demonstrates that claims 1-46 and 75-117 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



Alexander Shvarts
Registration No. 47,943
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000